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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,002	12/12/2000	Motoharu Seiki	2000-1617	6487

7590

07/15/2003

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EXAMINER

CANELLA, KAREN A

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 07/15/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/734,002

Applicant(s)

Seiki et al

Examiner

Karen Canella

Art Unit

1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 36-38 and 41-53 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-38 and 41-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 1642

### **DETAILED ACTION**

1. Claims 30-35 and 39-40 have been canceled. Claims 36-38 and 41-53 are pending and under consideration.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
3. Claim 50 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 49. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
4. Claims 36-38 and 41-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 52 is vague and indefinite in the recitation of MMP-1, MMP-2, MMP-3, MMP-7, MMP-8 and MMP-9. The use of laboratory designations only to define a limitation of a claim render the claim vague and indefinite because different laboratories can use different designations to name the same proteins or in the opposing scenario, can use the same designation to name different proteins. For instance, the instant specification states on page 6, that MT-MMP-3 was identical to the previous MT-MMP-2. This is a demonstration that the use of laboratory designations does not adequately set the metes and bounds of a claim.

Claims 36, 45, 46, 47 and 53 recite “residues of SEQ ID NO:2 which are characteristic of said MMP protein”. It is unclear what constitutes a characteristic of an MMP protein, therefore it is unclear how this limitation is applied to residues of said protein. Characteristic of a protein can be interpreted in many ways such as enzymatic activity, protein domain, immunogenic fragment, antigenic fragment, etc.

Art Unit: 1642

5. Claim 37 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation of further comprising the peptide fragment of Ala564 to Phe587 would be inherent in the protein of salt thereof of claim 37 which carries the limitation of comprising the peptide fragment of Asp533 to Val607.

6. The rejection of claims 36-41, 43, 45-47, 49-53 under 35 U.S.C. 102(a) as being anticipated by Takino et al (Journal of Biological chemistry, Sep 1995, Vol. 270, pp. 23013-23020) is withdrawn in light of applicants foreign translation of the priority application.

7. The rejection of claims 36-53 under 35 U.S.C. 103(a) as being unpatentable over Takino et al (Journal of Biological Chemistry, Sep 1995, Vol. 270, pp. 23013-23020) in view of Paul (Fundamental Immunology, (text), 1993, page 460) and Thrope and Rafferty (Preparation and Use of Radio labeled Antibodies and antigens, In: Immunochemistry LabFax, 1994, Kerr and Thrope Ed.s, pages 115-126) is withdrawn in light of applicants foreign translation of the priority application .

8. The rejection of claims 36, 41, 45, 46 and 53 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, is withdrawn in light of applicant amendments.

9. All other rejection and objections as set forth in Paper No. 13 are withdrawn.

Art Unit: 1642

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, reading "Karen A. Canella", followed by a horizontal line.

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

July 12, 2003